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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/089,810	08/05/2002	Lutz Brandt	FA-1068	3040

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Wilmington, DE 19898

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/089,810

Applicant(s)

BRANDT ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other.

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 10-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Betz et al (US 6,261,645).

Betz et al disclose a process for producing scratch resistant (See column 2, lines 61-67; column 3, lines 1-8) multicoat finishes in which a pigmented basecoat applied to the substrate surface, a clear topcoat radiation curable coating composition comprising binders based on prepolymers or oligomers such as urethane acrylates (methacrylates) (See column 5, lines 47-54, 62, 64) is applied atop the resultant basecoat film, and then the topcoat film is cured (See column 9, lines 33-36, 57-67) by means of radiation, preferably by means of UV radiation (See column 10, lines 6-10). Aliphatic urethane acrylates (methacrylates) are particularly preferred binders (See column 6, lines 2-5), which are made by reacting polyisocyanurate of hexamethylene (hexane) diisocyanate, i.e. polyisocyanates based on acyclic aliphatic diisocyanate having 8 C atoms (See column 11, lines 13-15) with hydroxyalkyl methacrylate and diols/polyols (See column 7, lines 14-54). The binders can be used in the coating composition in an amount 5-90 wt % (See column 8, lines 14-21). The coating composition may if desired include one or more reactive diluents, which are employed preferably in an amount of from 0 to 70% by weight, with particular preference from 15 to 65% by weight, based in each case on the overall weight of the

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coating composition in the case of clear coats (See column 8, lines 22-34). The prepolymers or oligomers normally have a number-average molecular weight of from 500 to 50,000, preferably from 1000 to 5000 and preferably have at least 2 and, with particular preference, from 3 to 6 double bonds per molecule, and preferably also have a double bond equivalent weight of from 400 to 2000, with particular preference from 500 to 900 (See column 6, lines 12-23). The coating composition is particularly suitable as a topcoat for producing a multicoat finish in the sector of the automotive OEM finishing and/or automotive refinishing (i.e. over outer finish) of car bodies and parts thereof and also truck bodies, and the like (See column 10, lines 1-5).

It is the Examiner's position that a clear topcoat of Betz et al is a lacquer coating or sealing coat *inherently* since it is produced by a method identical or substantially identical processes to that of claimed invention.

It is held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, *claimed properties or functions are presumed to be inherent*. See MPEP 2111.02, 2112.01. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Betz et al (US 6,261,645).

Betz et al, as applied above, fail to teach that the clear topcoat is applied to areas of outer finish susceptible to scratching (Claim 23) such as near locks, door handles, etc. (Claim 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a coating composition of Betz et al to areas of outer finish susceptible to scratching such as near locks, door handles, etc. with the expectation of providing the desired scratch resistance, since Betz et al teach that the coating composition is scratch resistant (See column 2, lines 61-67; column 3, lines 1-8) and is particularly suitable as a topcoat for producing a multicoat finish in the sector of the automotive OEM finishing and/or automotive refinishing (i.e. over outer finish) of car bodies and parts thereof and also truck bodies, and the like (See column 10, lines 1-5).

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*ET*

Elena Tsoy  
Examiner  
Art Unit 1762

June 11, 2003

  
SHRIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
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